

Remarks

Claims 1-11 & 13-20 are at issue. Claims 1-11, 13-14, 16 & 18-20 stand rejected under 35 U.S.C. 103(a) as being anticipated by Pepe et al in view of "Import Personal Address Book (PAB) to Outlook 97" by Grant Miller. Claims 1-9 stand rejected under 35 USC 112, first paragraph.

Claim 1 has been amended to overcome the 35 USC 112, first paragraph rejection.

Claim 1 stands rejected under Pepe et al and Miller. Miller describes a method for transferring a personal address book in Microsoft Mail to Outlook 97. The end result of the process is that the "Personal Address Book" is now one of the selections in your Outlook address book. There are at least two problems with this rejection.

1. Claim 1 requires a "personal communication device". The specification defines these to include cellular (PCS-Personal Communication Systems) telephones, pagers and PDAs. There is no suggestion that Overlook is capable of working on any of these devices.

2. Overlook stores the addresses in a new .pab file. It does not store the addresses in the same address database as required by the claim.

Claim 1 is allowable over the prior art.

Claims 2 & 5-7 are allowable as being dependent from an allowable base claim.

Claim 3 requires the wireless communication link have a protocol that encapsulates a wide area network protocol. The applicant traverses the Examiner's Official Notice and demands that the Examiner find a reference with this feature.

Claim 4 is rejected by the Examiner by the statement "it would have been obvious to one skilled in the art at the time". The applicant traverses

the Examiner's rejection and demands that the Examiner find a reference with this feature.

Claim 8 requires that the address transfer program request a file name for the transfer. Neither Miller or Pepe discuss an address transfer program that requests a file name. The analogy with Miller requires that the address transfer program be Microsoft Mail. Microsoft Mail does not request a file name, Outlook does. But Outlook cannot be considered the address transfer program. Claim 8 is allowable over the prior art.

Claim 9 requires that the address transfer program allow the user to select fields for transfer. As stated above only Microsoft Mail could be considered the address transfer program. Microsoft Mail does not allow a user to select fields of their address book to be sent. Claim 9 is allowable over the prior art.

Claim 10 stands rejected under Pepe et al and Miller. Miller describes a method for transferring a personal address book in Microsoft Mail to Outlook 97. The end result of the process is that the "Personal Address Book" is now one of the selections in your Outlook address book. There are at least two problems with this rejection.

1. Claim 10 requires a "personal communication device". The specification defines these to include cellular (PCS-Personal Communication Systems) telephones, pagers and PDAs. There is no suggestion that Overlook is capable of working on any of these devices.

2. Overlook stores the addresses in a new .pab file. It does not store the addresses in the same address database as required by the claim.

Claim 10 is allowable over the prior art.

Claim 11 requires the transfer of address to go in the opposite direction. There is no suggestion in Miller that the transfer be bi-directional. Claim 11 is allowable over the prior art.

Claims 13, 15-17 are allowable as being dependent from an allowable base claim.

Claim 14 requires selecting a field in the file of addresses. Nothing in Miller suggests that fields of the address database can be selected.

Claim 18 requires displaying an address transfer option. This is clearly not shown in either Miller or Pepe.

Claim 19 is allowable as being dependent from an allowable base claim.

Claim 20 requires selecting a field in the file of addresses. Nothing in Miller suggests that a field of the address database can be selected.

Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

(Hiatt, Jr.)

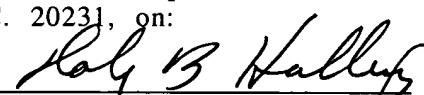
By


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I hereby certify that an Amendment is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on:

10/25/01

Date


Signature (Dale B. Halling)

In the claims (Markup Version)

Please cancel claims 12.

1 (3rd amendment). A system for transferring an address list, comprising:

a [portable wireless electronic device] personal communication device containing an address database;

a wireless communication system capable of establishing a wireless communication link with the [portable wireless electronic] personal communication device;

a wireline communication network connected to the wireless communication system; and

a computer connected to the wireline communication network, the computer containing an address software that is capable of extracting a plurality of addresses in an address database and sending the plurality of addresses to the [portable wireless electronic] personal communication device, the personal communication device storing the plurality of addresses in the address database of the [portable wireless electronic] personal communication device, wherein the computer is not part of the wireline communication network and is not part of the wireless communication system.

2(amended). The system of claim 1, wherein the [portable wireless electronic] personal communication device is a cellular telephone.

10 (Twice amended). A method of transferring an address list, comprising the steps of:

- (a) selecting an address transfer program at a first electronic device, the first electronic device is not part of a wireline communication network and is not part of a wireless communication system, the first electronic device containing a first address book;
- (b) entering an electronic address of a [second electronic] personal communication device, the [second electronic] personal communication device is not part of the wireline communication network and is not part of the wireless communication system, the personal communication device containing a second address book;
- (c) setting up a communication path between the first electronic device and the [second electronic] personal communication device, the communication path including a wireless portion and a wired portion; and
- (d) transferring [an] a plurality of addresses from the first address book to the second address book.

11(Amended). The method of claim 10, wherein step (d) further includes the step of:

- (d1) transferring the plurality of addresses from the [second electronic] personal communication device to the first electronic device.

18(Amended). A computer-readable program containing computer-readable instructions that when executed by a computer performs the following steps:

- (a) displaying an address transfer option that extracts a plurality of addresses from an address database;
- (b) requesting an electronic address of an electronic device, when the address transfer option is selected;
- (c) establishing a communication link with the electronic device through a communication network; and
- (d) receiving [a] the plurality of addresses at the electronic device and storing the plurality of addresses in an address list of the electronic device.